

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

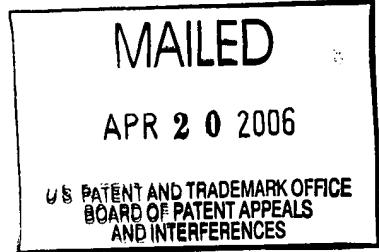
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. EDWARDS, ANDREW M. JONES, and ANTHONY W. RICH

Appeal No. 2006-0838
Application No. 09/410,642

ON BRIEF



Before JERRY SMITH, RUGGIERO and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-19 and 21-36, which constitute all the claims pending in this application.

The disclosed invention pertains to a circuit for detecting and analyzing information contained in an information packet on a circuit interconnect.

Representative claim 1 is reproduced as follows:

1. In a system comprising an interconnect and a plurality of modules connected to said interconnect for putting packets of information onto the interconnect, wherein each

packet comprises a number of fields containing information including both data and packet routing information, wherein each module has a unique identification on the interconnect and wherein the routing information identifies at least one of the modules associated with the data, a circuit comprising:

 circuitry for receiving at least part of said information;

 circuitry for determining if said at least part of said information satisfies one or more conditions; and

 circuitry for performing one or more actions in response to the determination that at least part of the information satisfies one or more conditions.

The examiner relies on the following references:

Wolff et al. (Wolff)	4,486,826	Dec. 04, 1984
Merrill et al. (Merrill)	4,942,552	July 17, 1990
Ardini, Jr. et al. (Ardini)	4,918,693	Apr. 17, 1990
Pizzica	5,652,754	July 29, 1997
Bershteyn et al. (Bershteyn)	5,678,028	Oct. 14, 1997
Goodrum et al. (Goodrum)	6,032,271	Feb. 29, 2000
		(filed June 05, 1996)
Cepulis	6,055,596	Apr. 25, 2000
		(filed June 05, 1996)

The following rejections are on appeal before us:

1. Claims 1-6, 11-13, 15-18, 21, 22 and 25-34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Wolff.
2. Claims 1, 22 and 33-36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Goodrum.
3. Claims 7-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Wolf in view of Cepulis.

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4. Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Wolf in view of Ardinini.

5. Claims 19 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Wolf in view of Pizzica.

6. Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Wolf in view of Bershteyn.

7. Claim 36 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Wolf in view of Merrill.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

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It is our view, after consideration of the record before us, that the evidence relied upon supports each of the examiner's rejections of the claims on appeal. Accordingly, we affirm.

We consider first the rejection of claims 1-6, 11-13, 15-18, 21, 22 and 25-34 under 35 U.S.C. § 102(b) as being anticipated by Wolff. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Since appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider independent claim 1 as the representative claim for this rejection.

The examiner has indicated how the claimed invention is believed to be fully met by the disclosure of Wolff [answer, pages 3-7]. Appellants argue that the set of signals described by Wolff would not be construed as a packet by a person skilled in the art. They also argue that the examiner's definition of a

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packet, that is, "a serial stream of clocked data bits" is not supported by any authority and contradicts the commonly accepted meaning. Appellants note that a "packet" requires that the data be transferred as a unit and not as a serial stream of data bits. Appellants also offer a definition of "packet" from a telecom dictionary. Appellants note that the claimed packet routing information is not included in the bus-type interconnect of Wolff. Finally, appellants argue that Wolff does not determine whether one or more conditions are satisfied because there is only one condition in Wolff [brief, pages 4-6].

The examiner responds that there are many definitions of the term "packet," and the examiner notes that the definition he has used is specifically approved by the IEEE 100, The Authoritative Dictionary of IEEE Standards and Terms. The examiner asserts that the telecom definition proffered by appellants is incorrect because the claimed invention does not involve a telecom system. Even if appellants' definition of "packet" is accepted, the examiner responds that the data in Wolff includes address information (packet routing information) because there is more than one source and more than one destination possible in the system of Wolff. With respect to the "one or more" limitation, the examiner notes that such limitation is met by a teaching of just one. Finally, the examiner notes

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that the transfer cycle as defined by Wolff would be a packet [answer, pages 16-20].

We will sustain the examiner's rejection for the reasons essentially argued by the examiner in the answer. The examiner was correct to give the term "packet" its broadest reasonable interpretation during prosecution. This rule is followed because an applicant is free to amend the claims during patent prosecution. These claims on appeal could easily be amended to provide a definition for the term "packet" which would require the claim construction that appellants now argue. Since the term "packet" has many different definitions depending on the particular art in which it is used, appellants cannot be allowed to arbitrarily assert a particular definition of the term which is unsupported by the claims or the specification. Therefore, we agree with the examiner that the information transferred in Wolff exists as packets of information within the broadest reasonable interpretation of claim 1. We also note that the examiner has explained why the transfer cycle of Wolff is considered to be a packet as claimed. Appellants have not pointed out any specific error in the examiner's analysis.

We now consider the rejection of claims 1, 22 and 33-36 under 35 U.S.C. § 102(e) as being anticipated by Goodrum. Since appellants' arguments with respect to this rejection have treated

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these claims as a single group which stand or fall together, we will consider independent claim 1 as the representative claim for this rejection. The examiner has indicated how the claimed invention is believed to be fully met by the disclosure of Goodrum [answer, pages 7-9].

Appellants argue that Goodrum, like Wolff, fails to show or suggest monitoring information from packets containing information. Appellants argue that the packets identified by the examiner are not packets because they are not a unit of data of finite size that is transmitted as a unit [brief, pages 6-7]. The examiner responds that even though the word "packet" is not used in Goodrum, the information transmitted in Goodrum is in the form of a packet. The examiner asserts that the bits shown in the table in column 14 of Goodrum are transmitted as a unit in a phase of a transaction [answer, pages 20-21].

We will sustain the examiner's rejection for the reasons essentially argued by the examiner in the answer. As noted above, the examiner was correct to give the term "packet" its broadest reasonable interpretation during prosecution. Therefore, we agree with the examiner that the information transferred in Goodrum exists as packets of information within the broadest reasonable interpretation of claim 1. We also note that the examiner has explained why the information of Goodrum is

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considered to be a packet as claimed. Appellants have not pointed out any specific error in the examiner's analysis.

We now consider the various rejections under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness.

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Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii) (2004)].

The examiner has explained why the rejected claims are believed to be unpatentable over the applied prior art [answer, pages 9-16]. Specifically, the examiner has pointed out the teachings of Wolff, has pointed out the perceived differences between Wolff and the claimed invention, and has reasonably indicated how and why Wolff would have been modified to arrive at the claimed invention. The examiner has, therefore, at least satisfied the burden of presenting a *prima facie* case of obviousness. The burden is, therefore, upon appellants to come forward with evidence or arguments which persuasively rebut the

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examiner's prima facie case of obviousness. Appellants' only argument with respect to these rejections is that none of the supplementary references overcome the deficiencies in the Wolff reference discussed above [brief, page 7].

We will sustain the examiner's rejection of claims 7-10, 14, 19, 23, 24, 35 and 36 because we have determined that there are no deficiencies in Wolff and because appellants have offered no persuasive arguments to rebut the examiner's prima facie case of obviousness.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-19 and 21-36 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

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AFFIRMED

Jerry Smith

JERRY SMITH)
Administrative Patent Judge)

Joseph F. Ruggiero

JOSEPH F. RUGGIERO)
Administrative Patent Judge)

Lance Leonard Barron

LANCE LEONARD BARRON)
Administrative Patent Judge)

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